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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------|------------------------|
| 10/789,573 | 02/27/2004 | Erik J. Burckart | RSW920040010US1 (152) | 7945 |
| 46320 7590 10/02/2008 CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP STEVEN M. GREENBERG 950 PENINSULA CORPORATE CIRCLE SUITE 3020 BOCA RATON, FL 33487 | | | EXAMINER CHANG, JUNGWON | |
| | | | ART UNIT 2154 | PAPER NUMBER |
| | | | MAIL DATE 10/02/2008 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|---|--------------------------------------|--|-----------|
| Pre-Interview Communication (For use in the First Action Interview Pilot Program) | Application No. 10/789,573 | Applicant(s) BURCKART ET AL. | |
| | Examiner JUNGWON CHANG | Art Unit 2154 | Page 1 of |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **ONE MONTH OR THIRTY (30) DAYS**, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

This time period for reply is NOT extendable under 37 CFR 1.136(a). This communication constitutes notice under 37 CFR 1.136(a)(1)(i).

To avoid abandonment of the application, applicant must, within this time period for reply, file:

- (1) A letter requesting not to have a first-action interview, or
- (2) A completed Applicant Initiated Interview Request Form (PTOL-413A) accompanied by a proposed amendment or arguments.

Inventor participation in the Pre-First Action Interview is encouraged if it would expedite resolution of the application.

Disposition of Claims

- 3) ☒ Claim(s) 1,5,12 is/are pending in the application.
 3a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 4) ☐ Claim(s) _____ is/are allowed.
- 5) ☒ Claim(s) 1,5,12 is/are rejected.
- 6) ☐ Claim(s) _____ is/are objected to.
- 7) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 8) ☐ The specification is objected to by the Examiner.
- 9) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 10) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 11) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

Contact Information

Examiner's Telephone Number: (571)272-3960
 Examiner's Typical Work Schedule: M-F 6:30 - 2:00
 Supervisor's Name: Nathan Flynn
 Supervisor's Telephone Number: 571-272-1915

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>2/27/04, 6/30/05</u> | 6) <input type="checkbox"/> Other: _____ |

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|---|------------------------------------|--|-----------|
| Pre-Interview Communication (For use in the First Action Interview Pilot Program) | Application No. 10789573 | Applicant(s) BURCKART ET AL. | |
| | Examiner JUNGWON CHANG | Art Unit 2154 | Page 2 of |

Notification of Rejection(s) and/or Objection(s)

| # | Claim(s) | Reference(s) (if applicable) | Rejection Statutory Basis | Brief Explanation of Rejection |
|---|----------|---------------------------------|------------------------------|---|
| 1 | | | Specification objection | Specification is objected to as failing to provide proper antecedent basis for the claim terminology "computer-readable storage device" Please see 37 CFR 1.75(d)(1) and MPEP 608.01(o)). Claim 12 discloses "computer-readable storage device" but the term is not described in the specification. |
| 2 | 1,5,12 | Mentze et al. Lund | 103(a) | Mentz discloses claims 1, 5 and 12 (col. 1, line 58 - col. 2, line 16, "recommending an available network protocol to a user"; col. 3, lines 8-37, "if IPX is not supported by the client...determine whether the client supports IP protocol") except for (see cont.) |
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Expanded Discussion/Commentary

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| | | "reversing an order of the created listing". Lund discloses reversing an order of the created listing (page 3, 0033, "protocols stored in the list may be re-arranged according to a different order"). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teaching of Mentz and Lund because Lund's teaching would update the protocol lists by re-arranging according to a different order, as taught by Lund, page 3, 0033. |
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| DATE: 9/30/2008 | | /JUNGWON CHANG/ Primary Examiner, Art Unit 2154 |